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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,311	12/04/2001	William D. Griffith	N1086-072	8905

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EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

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DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,311

Applicant(s)

Griffith

Examiner

Fox

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/21/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-19, 21, 24, 26-28, 30-31 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 1-5, 7, 9-11 is/are allowed.
- ☒ Claim(s) 6, 8, 12-19, 21, 24, 26-28, 30-31 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's amendments of 21 April 2003 and accompanying statements and arguments have overcome the following rejections: the enablement rejection with regard to a deposit, the indefiniteness rejection of claim 31, and the art rejections of record.

Claims 6, 12-19, 21, 24, 26-28 and 30-31 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, as stated on pages 4-6 of the last Office action for claims 6 and 11-32.

Claims 6, 12-19, 21, 24, 26-28 and 30-31 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on pages 6-8 of the last Office action for claims 6 and 11-32.

Claim 11 is now being interpreted as a method for making an F1 hybrid comprising a single generation of crossing the exemplified inbred with another plant. Since the exemplified inbred is adequately described, and since guidance for a method of using that inbred in a single outcross has been provided, this claim is now considered to meet the requirements of 35 USC 112, first paragraph.

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Claims 6, 8 and 26-28 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as stated on pages 10-11 of the last Office action.

The claims are deemed free of the prior art, given the failure of the prior art to teach or suggest an inbred corn plant with the unique genetic and morphological complement of the exemplified corn plant, or methods of its use for classical breeding or transformation. The PVP Office-executed Search cited in the last Office action is now considered inappropriate, as the ranges of the search parameters were unduly broad.

Claims 1-5, 7 and 9-11 are allowed.

Applicant's arguments filed 21 April 2003, insofar as they pertain to the rejections above, have been fully considered but they are not persuasive.

Applicant urges that the written description rejection is improper, given the description in the specification of four hybrids using the exemplified inbred as a parent, the conservation of the same half of the genetic contribution from the exemplified inbred parent in all recipient hybrids, and the disclosure of many transgenes in the specification.

The Examiner maintains that the claims are not limited to the four exemplified hybrids, which four individual hybrids are admittedly adequately described. Since Applicant has not provided any actual characterization of the entire genome of the exemplified inbred, or even half of its genome, Applicant has not disclosed any structural features which would be common to the genomes of all hybrids derived from the inbred.

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Regarding the transgenes, Applicant has not provided any structural sequences common to all of the transgenes which were correlated with function. Furthermore, Applicant has not described any transformed inbred plant which would retain all of the features of the exemplified inbred except for the introduced transgene-encoded trait. Applicant has only described the exemplified inbred with respect to a collection of traits. It is unclear how the introduction of a multitude of non-exemplified transgenes, encoding a multitude of proteins or enzymes or inhibitory RNA products which would be involved in a multitude of metabolic pathways resulting in a multitude of traits, would interfere with one or more of these traits. Such interference would result in the production of a multitude of corn plants with a different collection of traits than the exemplified inbred. Since no genetic characterization of the inbred was initially provided, and since the only identifying description, namely the unique collection of traits, has now been obliterated, the genus of corn plants transformed with a multitude of non-exemplified transgenes would be inadequately described. It is noted that claims limited to a method of producing a transgenic corn plant comprising transforming the exemplified inbred with single, known transgenes recited in the specification, and the resultant corn plant produced by that process, would in fact be adequately described, as stated in the last Office action.

Applicant urges that the remaining enablement rejection is improper, given the disclosure in the specification of various means of corn plant transformation, and the lack of relevancy or persuasiveness of the references cited by the Examiner to support his position.

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The Examiner maintains that the ability to produce transformed corn plants in general is not disputed. Rather, the specification fails to enable the production of corn plants which would be identical to the exemplified inbred except for a single trait, following the introduction of a multitude of non-exemplified transgenes encoding products involved in a multitude of metabolic pathways which would affect a multitude of traits.

Regarding the references cited by the Examiner, the Examiner maintains that the references do in fact demonstrate the unpredictability inherent in the process of introgressing single traits into various plants of different genetic backgrounds, and the unpredictability inherent in utilizing molecular breeding techniques in crop plants. The fact that these references are not specific to corn is immaterial. The references demonstrate the widespread phenomenon of unpredictability throughout cultivated plant species, and Applicant has not provided any guidance to overcome this unpredictability.

Applicant urges that the indefiniteness rejections are improper, given the amendment of the claims and the proper further limitation by claims 6 and 8 of the claims from which they depend.

The Examiner maintains that the amendments to claims 6 and 8 do not address their deficiencies. Amendment of claim 8 as suggested in the last Office action is suggested, to provide adequate antecedent basis for "protoplasts" in the claim.

Regarding claims 6 and 26, the Examiner maintains that the independent claim from which they depend is drawn to a maize plant with a particular set of characteristics and a particular allele

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at every genetic locus. Thus, to later claim a plant which has even one different characteristic and a different gene or allele at even one locus fails to further limit the independent claims, since the dependent claims negate the characteristics of the plant of the independent claim, rather than merely adding to them. For example, rendering the male fertile plant of claim 2 as simultaneously male sterile (as recited in claim 6) fails to further limit the original plant. Applicant is directed to the suggested claim amendments provided in the last Office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

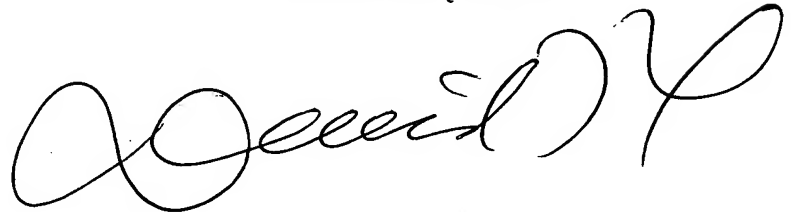
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

June 26, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1801638

A handwritten signature in black ink, appearing to read "David T. Fox", written in a cursive style.